



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Ser. No.:	Filed:	First Inventor:	Atty Dkt:
10/807,810	24 March 2004	M. Albanese	172MA-001 (10555-6)
Title: Adherent thin film with leading edge identifying indicia			
Examiner: A. Desai Art Unit: 1771			

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE and Request for Reconsideration

Dear Sir:

In complete and timely response to the action mailed 26 July 2006, reexamination and reconsideration of the application, in light of the following remarks, are respectfully requested.

The courtesy of the interview on 8 August 2006 with the examiner and his supervisor is much appreciated. As discussed during the telephonic interview, and noted on the continuation sheet attached to the Interview Summary (PTOL-413), the claims were previously limited to electrically insulating tape having two lines from end to end. Also discussed was the possibility of submitting declarations under §1.132 in respect of the usefulness of the invention and/or long felt need for a solution to the problem.

Prior to addressing the substance of the prior art rejection, the rejection under 35 U.S.C. §112, first paragraph, on the ground that the recitation of an "unscored" length is a negative limitation not "fully" supported by the specification, is respectfully traversed. As the claims are not to be read in a vacuum, and the claims and specification do support "electrically insulating," it would be understood by one of ordinary skill in arts relating to insulation that any perforation in an insulating layer is a defect because electrical charge can pass through. The "unscored" limitation was added to distinguish cited art (Thomason's toilet tissue). That what applicant claims is less than that what is disclosed is *not* conclusive of a lack of support. "To rule otherwise would let form

triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was the first with the genus when he filed.” *In re Saunders*, 170 USPQ 213, 220 (1971). *Ex parte Grasselli*, cited in the rejection, is inapposite because in that case the negative limitations introduced new concepts in violation of the description requirement. If it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art that applicant had possession of the concept of an unscored electrically insulating tape, then the claim satisfies the requirements of the first paragraph of §112. *Ex parte Parks*, 30 U.S.P.Q.2d 1234 (B.P.A.I. 1993) (distinguishing *Grasselli*). Just as a balloon with a perforation will not hold air, an insulator with a perforation does not insulate. Accordingly, this rejection should be withdrawn.

Regarding the rejection under 35 U.S.C. §112, second paragraph, the original claims and specification recite “solid color.” A change in the color of the line along the length of the tape could defeat the purpose of the invention because any random length of tape may be needed at any one time. Accordingly, that term has the dictionary definition of a single color (e.g., *Webster’s Ninth New Collegiate Dictionary* (Springfield, MA: Merriam-Webster, Inc., 1989)). Accordingly, this rejection should now be withdrawn.

Turning now to the prior art rejection, claims 17, 19-23, and 42-43 stand rejected as obvious over Figliuzzi in view of Thomason and Hughey (*et al.*), which rejection is respectfully traversed.

Part of the traversal of this rejection includes the four §1.132 declarations submitted herewith. The declarations from Messrs. Smith, Jr., and Iovino explain their involvement in the electrical contracting industry (for 21 and 7 years, respectively). Each had employees use the tape and found it was not only easier to locate the end, but also to unwind the tape from a splice or connection and redo the connection. Similarly, installing and maintaining vacuum installations (such as machining exhaust and home vacuum systems) requires electrical connections, and the declaration from Mr. Stani, who has been involved with vacuum systems for 11 years, attests to similar benefits. The declaration of Mr. Rutigliano attests to the “very successful” consumer demand, that returning customers want more, and that he uses the tape himself because he does not have to use as much. All of the declarations note that the tape has two wavy lines along the length of the outside surface.

The rejection acknowledges that the primary reference Figliuzzi fails to disclose multiple lines and only appreciates finding the end of the tape while still on the roll. Thomason shows an “overlap [of two lines] at preselected segment increments” (col. 2, ln. 5-6), such as in Fig. 2, but there is an overlap on only two adjacent segments and no overlap on the next two segments. The allegation that it would have been obvious to use two lines to enhance the aesthetics does not appear to be based on any teaching or suggestion in the references, and does not appear to relate to any problem addressed by either reference. Rather, none of the references disclose two lines each running the entire length of the tape. While Thomason may have some segments with two lines, the present claims require any arbitrary segment to have two lines. Thomason thus teaches away from the claimed limitation by disclosing segments having only one line. Any arbitrary length of the Thomason article might have one line or might have two lines. The claims are not rendered obvious by a disclosure that does not necessarily reach the same result, and it is impermissible to pick and choose only so much of a reference disclosure as will support a rejection.

Perhaps more importantly, none of the cited references addresses the problem of unwinding the tape from a spliced connection, as discussed during the telephonic interview. The attached declarations from the contractors specifically mention that the tape they used, having two lines, makes it easier not only to find the end when the tape is still on the roll, but also to locate the end on a splice or other connection. As discussed during the interview, it is unwise to cut into a splice to remove the tape because wires may be cut, and often there is a limited amount of wire available for the splice. As Mr. Smith, Jr., notes in his declaration, he personally witnessed occasions where the ability to find the end on a splice saved his company time and money.

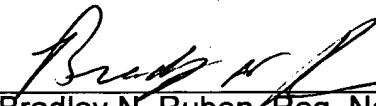
In Thomason, the problem is to find the “beginning or usable end . . . of products manufactured in a roll form” (col. 1, ln. 5-6). There is no disclosure of finding a useable end to unwind an indefinite length strip after installation.

Hughley is concerned with the manufacture of a cable, and not with unwinding the tape from a cable. Hughley is specifically directed to a highly transparent polyolefin tape wherein a die is added to the entire substrate to differentiate the indexing of different layers of tape (substrates). Further, the polyolefin tape has a “low dielectric constant” (col. 7, ln. 28). Accordingly, the Hughley tape is not at all related to that claimed. Hughley’s teaching to add a dye to color a transparent tape does not result in the Fuglizzi tape having multiple colors, as the rejection appears to suggest. There is no disclosure how one would make a single tape having two different and separate

dyes to differentiate the layers within a roll. Rather, Hughley teaches making different tapes, each dyed differently, in the manufacture of the cable "to easily distinguish the edges, the butt gaps, of the immediate previous layer [from lower layers]." (Col. 8, ln. 60-65.) Having a line in the Hughley tape would obscure any edges or gaps in the underlying tape layers. Thus, Hughley adds nothing more than teaching using a dyed transparent substrate for the tape.

In conclusion, none of the references shows or suggests two lines running the length of the tape, or appreciates the problem of finding the end of the tape on an existing splice to unwind the installed tape. Declarations are submitted by those with knowledge of the industry, and having worked in the industry for a significant period of time, either as a user (a contractor) or as a retailer. This evidence shows that a tape having two lines along its length satisfies an important problem in the industry (as described in the specification), a problem that has existed for some time. Accordingly, all of the rejections should now be withdrawn and further and favorable action, in the form of a Notice of Allowance, is believed to be next in order, and such action is earnestly solicited.

Respectfully submitted,



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3 October 2006

**CERTIFICATE OF MAILING OR
TRANSMISSION – 37 CFR 1.8**

I hereby certify that I have a reasonable basis that this paper, along with any referred to above, (i) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, or (ii) are being transmitted to the U.S. Patent & Trademark Office in accordance with 37 CFR § 1.6(d).

DATE: 3 Oct. 2006

NAME: Brad Ruben

SIGNATURE: 